REMARKS

Entry of this Amendment is respectfully requested.

This Amendment is in response to the Office Action dated November 3, 2004.

By the present Amendment, claim 1 has been amended along the lines suggested in paragraph 37 of the Office Action. Appreciation is expressed to the Examiner for the suggestion for amending claim 1 to overcome the 35 U.S.C. § 112, second paragraph, rejection. By virtue of this Amendment, reconsideration and removal of the 35 U.S.C. § 112 rejection of claim 1, and its dependent claims, is respectfully requested. Entry of this Amendment is also respectfully requested in light of the fact that this Amendment simply adopts the language proposed by the Examiner. Under 37 CFR § 1.116, entry of amendments after final rejection is appropriate when Applicants are following suggestions made by an Examiner. Accordingly, entry of this Amendment is earnestly solicited.

Turning to the prior art rejections set forth in the Office Action, reconsideration and removal of these prior art rejections is respectfully requested for the following reasons. To begin with, it is noted that all of the prior art rejections set forth in the Office Action are based on the U.S. Patent 6,209,026 to Ran, either alone or in combination with other cited prior art. It is respectfully submitted that, as such, these rejections are based upon a misunderstanding or misapplication, of the teachings of Ran, as will be discussed below.

As noted in the Remarks of the previously filed Amendment of July 22, 2004, an important aspect of the present invention is the fact that it deals with real time update of information immediately upon changes of monitored parameters. This real time update is completely opposite the arrangement in Ran which simply utilizes

periodic updates. The reliance of periodic updates can be seen, for example, in column 8, lines 55-59 and in column 11, lines 34-38 of the Ran reference.

Obviously, real time updating and periodic updating are quite different from one another. This difference has even been recognized in the Office Action, for example, in paragraph 39 on page 12 in the statement "As to point (see), Ran teaches periodic updating." However, the Office Action goes on to state:

> "But that does not preclude Ran from teaching real time updates when information has changed. That is the purpose of the abnormal warnings taught by Ran."

It is respectfully submitted that this statement for supporting the rejection actually falls within the realm of "obvious to try" logic. Which has been specifically found to be improper by both the CAFC and its predecessor, the CCPA, in formulating a rejection.

For example, in a classic case on this matter, In re Antonie, 195 USPQ 6, the court studied a situation where the Office Action proposed modifications of parameters since, in the Examiner's view, it was obvious to try these modifications to arrive at the claimed invention. In addressing this issue, the CCPA stated:

> "The PTO and the minority appear to argue that it would always be obvious for one of ordinary skill in the art to try varying every parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter affected the result. As we have said many times, obvious to try is not the standard of 35 U.S.C. § 103." 195 USPQ at 8 (Underlining original).

This same judicial logic has been applied by the CAFC in the case of In re Fine, 5 USPQ 2d 1596. In that case, in addressing the question of whether two references could be combined to arrive at the claimed invention, the court stated:

> "The Eads and Warnick references disclosed, at most, that one skilled in the art might find it obvious to try the claimed invention. But whether a particular combination might be "obvious to try" is not a legitimate test of patentability." 5 USPQ 2d at 1599.

In the present instance, it is respectfully submitted that the statement that, although Ran teaches periodic updating "that does not preclude Ran from teaching real time updates when information is changed" clearly falls within this prohibited "obvious to try" rationale. As noted above, clearly periodic updating and real time updating are completely different from one another. It is respectfully submitted that there is no teaching or suggestion of real time updates in Ran. Therefore, any modification of Ran to arrive at the present claimed invention would necessarily be based on "obvious to try" reasoning.

MPEP 2143.01 also recognizes that the mere fact that references can be combined or modified is not sufficient to establish obviousness (e.g., see MPEP page 2100-131 of the May 2004 revision). As noted there:

> "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Page 2100-131 also notes that the mere fact that the claimed invention is "within the capabilities of one of ordinary skill in the art" is also not sufficient to establish obviousness. As noted at the outset of MPEP 2143.01, "the prior art must suggest the desirability of the claimed invention." (See page 2100-129). It is respectfully submitted that no such suggestion is at all found in Ran, or any of the cited secondary art.

In the Office Action, it is also states that the "real time updates would fall within the abnormal warnings taught by Ran." However, it is respectfully submitted

that even with abnormal warnings, there is no suggestion that Ran would check these in any manner other than the periodic updates. If the Examiner believes to the contrary, it is respectfully requested that the specific portions of Ran that teach real time updating for abnormal warnings be pointed out by the Examiner in the next Office Action. Otherwise, reconsideration and removal of all prior art rejections utilizing Ran is respectfully requested, together with allowance of the present application.

Applicants respectfully request that the Examiner contact the undersigned attorney for purposes of conducting an interview in this manner after having reviewed the above arguments, particularly if it is determined that the rejection will be maintained. Applicants and the undersigned attorney greatly appreciate the Examiner's courtesy and helpfulness in this regard.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 0171.38083X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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